IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR(S): Sangeetha Narasimhan   CONFIRMATION NO. 1711

SERIAL NO.: 09/726,966   GROUP ART UNIT: 2622

FILED: November 29, 2000   EXAMINER: Chan S. Park

TITLE: PRINT TONER DENSITY MODE/PRINT MEDIA DEFAULT LINK

APPEAL BRIEF

1.   **REAL PARTY IN INTEREST.**

   The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holding, LLC.

2.   **RELATED APPEALS AND INTERFERENCES.**

   There are no other appeals or interferences known to Appellant, Appellant's legal representative or the Assignee which will affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

3. STATUS OF CLAIMS.

Claims 1-5 and 7-11 are pending. Claim 6 has been canceled. The rejection of Claims 1-5 and 7-11 is appealed.

4. STATUS OF AMENDMENTS.

No amendments were filed after the final action.

5. SUMMARY OF CLAIMED SUBJECT MATTER.

The claimed subject matter relates to a printer controller automatically selecting one parameter setting (e.g., print media) based on a user selection of another parameter setting (e.g., toner density).

Claim 1, for example, is directed to a method for selecting a print job parameter that includes a printer controller ascertaining an operator-selected toner density setting and the printer controller automatically selecting a print media source based upon the operator-selected toner density setting. One example of the method of Claim 1 is illustrated in steps 11-12 in Fig. 1 and described in the Specification at page 4, lines 16-20 and page 5, lines 12-18.

Claim 4, for example, is directed to a method for selecting a print job parameter that includes a printer controller ascertaining an operator-selected print media source setting and the printer controller automatically selecting a toner density setting based upon the operator-selected print media source setting. One example of the method of Claim 4 is illustrated in steps 21-22 in Fig. 2 and described in the Specification at page 4, lines 20-24 and page 6, lines 1-6.

Claim 7, for example, is directed to a printer controller configured to automatically recognize a selection of one of a plurality of settings for a first print job parameter and, in response to recognizing the selection of the first print job parameter setting, automatically select one of a plurality of settings for a second print job parameter. A printer controller thus configured is described in the Specification at page 4, lines 16-24.

6. **GROUNDS OF REJECTION TO BE REVIEWED.**

1. Claims 1-3, 7, 8 and 10 stand rejected under Section 102(e) as being anticipated by Mantell (6189993).

2. Claims 4, 5, 9 and 11 stand rejected under Section 103 as being obvious over Mantell (6189993).

7. **ARGUMENT.**

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GROUND NO. 1

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Claims 1-3, 7, 8 and 10 stand rejected under Section 102(e) as being anticipated by Mantell (6189993).

Claims 1-3, 7, 8 and 10 stand rejected under Section 102(e) as being anticipated by Mantell (6189993). To support the Section 102 rejection, Mantell must teach each and every claim limitation, it must be enabling, and it must describe the claimed subject matter sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention. *Helifix Ltd. v. Blok-Lok*, 208 F.3d 1339 (Fed. Cir. 2000); *In re Paulsen*, 30 F.3d 1475 (Fed. Cir. 1994); MPEP § 2131.

Claim 1 recites a printer controller ascertaining an operator-selected toner density setting and the printer controller automatically selecting a print media source based upon the operator-selected toner density setting. Claim 7 recites a printer controller configured to automatically recognize a selection of one of a plurality of settings for a first print job parameter and, in response to recognizing the selection of the first print job parameter setting, automatically select one of a plurality of settings for a second print job parameter.

Printer Controller Ascertaining and Selecting.

There is no teaching in Mantell that his printer controller 21 is configured to or does actually ascertain any operator-selected settings or automatically select a print media source based on the operator-selected setting. On the contrary, it seems clear that any such acts in Mantell are performed by the user or by printer driver 84.

The Examiner asserts, in reply, that the claimed printer controller reads on printer driver 84 in Mantell. Advisory Action page 3. This assertion is not correct. It is clear

from the description of a printer at pages 3-4 of the Specification that a "printer controller" as claimed refers to a physical component of the printer that controls basic printer functions. Specification page 3, line 10 through page 4, line 14. Furthermore, Mantell explicitly distinguishes between a printer driver 84 and the printer controller 21. Mantell Figs. 1 and 4 and the accompanying text at column 3, lines 49-57 and column 6, line 61 through column 7, line 18.

<u>Recommending Is Not Selecting As Claimed</u>.

Mantell teaches a printer driver 84 recommending a print media by highlighting the recommended media in a selection menu.

"For instance, the user selects from a first screen 90 (see FIG. 5) of the user interface 86, one of a plurality of print quality modes 92, which can include, for instance, a draft mode 94, a normal mode 96, a high quality mode 98 and a deluxe quality mode 100. In addition, when one of the print quality modes 92 is selected, one of a plurality of media types 102 can be selected which include the selection of plain paper 104, coated paper 106, glossy high resolution paper 108 and glossy deluxe resolution paper 110. Print quality mode selections as well as media type selections affect image quality. *It is also possible, that upon selection of one of the print quality modes 92, the print driver 84 might automatically highlight one of the media types 102 as a recommendation to the user to use that type of media when printing in the selected print quality mode.* Upon selection of one of the print quality modes and one of media types, the user would, if satisfied with the selections, would [sic] select the OK selector 112 to begin printing." Mantell column 7, lines 45-63 (emphasis added).

In Mantell, the printer driver 84 makes a recommendation and the user makes a selection.

The Examiner argues that the claims read on Mantell because the claims do not "distinguish whether the automatic selection is the final selection or it requires another manual selection." Advisory Action page 3. Applicant acknowledges that Mantell refers to a highlighted print quality and/or media type menu item in Fig. 5 as a "selection." Mantell also refers to the act by which those "selections" are implemented as the act of selecting the OK selector 112 to begin printing. Indeed, either act might reasonably be seen to involve a selection in a general sense. However, "select" and "selecting" as used in the claims, reasonably construed in light of the Specification, refer to an act of consequence to the printer, not merely a preliminary act of no consequence to the printer. The printer controller selecting the draft media source in step 12 of Fig. 1 is

followed by the activation of the draft media source feed mechanism in step 13. The printer controller selecting a draft toner density mode in step 22 of Fig. 2 is followed by the activation of the draft media source feed mechanism in step 23. No user action is required (or even contemplated) after the automatic selection is made. Mantell does not teach automatically making such a selection.

For both of these reasons, Claims 1 and 7, and their respective dependent claims distinguish over Mantell under Section 102.

<u>Toner Density Setting.</u>

Claim 1 recites a printer controller ascertaining an operator-selected toner density setting and the printer controller automatically selecting a print media source based upon the operator-selected toner density setting. Claim 8, depending from Claim 7, recites that the first print job parameter comprises toner density and the second print job parameter comprises a source of print media.

Mantell is directed to an inkjet printer, not a laser printer. Mantell, therefore, does not teach any kind of toner density setting. Mantell does not teach the act of ascertaining a toner density setting (Claim 1) or automatically recognizing a toner density setting (Claim 8).

The Examiner argues in reply that the claimed toner density setting has been extended to an inkjet printer in the Specification at page 4, lines 5-15. Advisory Action page 2. Applicant acknowledges that the paragraph in the Specification describing an inkjet printer, including a printer controller for an inkjet printer, concludes with the following sentence.

"In addition and according to the present invention, the printer controller also may control selection of a print media default and a toner density setting." Specification page 4, lines 14-15.

This unfortunate sentence, which is clearly erroneous, will be amended at the earliest opportunity. (The error did not become apparent to Applicant until receipt of the Examiner's Advisory Action.) The identical sentence appears at the conclusion of the immediately preceding paragraph in the Specification describing the printer controller for an electrophotographic printer. See Specification page 3, line 22 through page 4, line 4. It is well known that an electrophotographic printer uses toner as the marking agent and

an inkjet printer uses ink (not toner) as the marking agent. The sentence referring to a toner density setting in connection with an inkjet printer, therefore, is clearly erroneous. Applicant respectfully submits that such an obvious error cannot properly be relied upon to preclude patentability.

For this addition reason, Claims 1 and 8 and their respective dependent claims distinguish over Mantell under Section 102.

<u>GROUND NO. 2</u>
Claims 4, 5, 9 and 11 stand rejected under Section 103 as being obvious over Mantell (6189993).

Claims 4, 5, 9 and 11 were rejected under Section 103 as being obvious over Mantell. To establish a prima facie case of obviousness, the Examiner must show that Mantell teaches or suggests all claim limitations. MPEP § 2143.

Claim 4 recites a printer controller ascertaining an operator-selected print media source setting and the printer controller automatically selecting a toner density setting based upon the operator-selected print media source setting. Claim 9 depending from Claim 7 recites a printer controller configured to automatically recognize a selection of one of a plurality of settings for a source of print media and, in response to recognizing the selection of the source of print media, automatically select one of a plurality of settings for a toner density. Claim 11 depending from Claim 9 recites that the printer controller is configured to automatically recognize a selection of a source of draft print media and, in response to recognizing the selection of a source of draft print media, automatically select a draft toner density setting.

The Section 103 rejections are based on the assertion that Mantell teaches the limitations of Claims 1 and 8 and that it would be obvious to modify these teachings in Mantell to do it "the other way" as recited in Claims 4 and 9. As noted above for the Section 102 rejections, Mantell fails to teach all of the limitations of Claims 1 and 8. For the same reasons, the modification of Mantell to reach Claims 4 and 9 must likewise fail.

That is to say, if Mantell does not teach a printer controller automatically selecting a print media source based upon a toner density setting, then Mantell cannot be modified to suggest a printer controller automatically selecting a toner density setting based upon a print media source setting.

Respectfully submitted,

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APPENDIX I -- CLAIMS INVOLVED IN THE APPEAL

1.   A method for selecting a print job parameter including the steps of:

a printer controller ascertaining an operator-selected toner density setting; and

the printer controller automatically selecting a print media source based upon the operator-selected toner density setting.

2.   The method of Claim 1 wherein:

the step of a printer controller ascertaining an operator-selected toner density setting comprises the printer controller ascertaining an operator-selected draft toner density setting; and

the step of the printer controller automatically selecting a print media source based upon the operator-selected toner density setting comprises the printer controller automatically selecting a draft media source based upon the operator-selected draft toner density setting.

3.   The method of Claim 1 wherein:

the step of a printer controller ascertaining an operator-selected toner density setting comprises the printer controller ascertaining an operator-selected standard toner density setting; and

the step of the printer controller automatically selecting a print media source based upon the operator-selected toner density setting comprises the printer controller automatically selecting a standard media source based upon the operator-selected standard toner density setting.

4.   A method for selecting a print job parameter including the steps of:

a printer controller ascertaining an operator-selected print media source setting; and

the printer controller automatically selecting a toner density setting based upon the operator-selected print media source setting.

5. The method of Claim 4 wherein:

the step of a printer controller ascertaining an operator-selected print media source setting comprises the printer controller ascertaining an operator-selected draft print media source setting; and

the step of the printer controller automatically selecting a toner density setting based upon the operator-selected print media source setting comprises the printer controller automatically selecting a draft toner density setting based upon the operator-selected draft print media source setting.

6.(canceled)

7. A printer controller configured to:

automatically recognize a selection of one of a plurality of settings for a first print job parameter; and

in response to recognizing the selection of the first print job parameter setting, automatically select one of a plurality of settings for a second print job parameter.

8. The printer controller of Claim 7, wherein the first print job parameter comprises toner density and the second print job parameter comprises a source of print media.

9. The printer controller of Claim 7, wherein the first print job parameter comprises a source of print media and the second print job parameter comprises a toner density.

10. The printer controller of Claim 8, wherein the printer controller is configured to:

automatically recognize a selection of a draft toner density setting; and

in response to recognizing the selection of a draft toner density setting, automatically select a source of draft print media.

11.   The printer controller of Claim 9, wherein the printer controller is configured to:

automatically recognize a selection of a source of draft print media; and

in response to recognizing the selection of a source of draft print media, automatically select a draft toner density setting.

APPENDIX II -- EVIDENCE SUBMITTED UNDER RULES 130, 131 OR 132

APPENDIX III -- RELATED PROCEEDINGS